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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,472

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David J. Mester

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,472

Applicant(s)

MESTER, DAVID J.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 11/2/05, the following has occurred: no claims have been amended, added, nor canceled. Now, claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13, 15-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks et al., U.S. Patent Application Publication No. 2004/0111379 in view of Barr et al., U.S. Patent No. 5,182,705.
4. As per claim 1, Hicks teaches a method of processing a customer claim against a manufacturer's product, said method includes the steps of: inputting the claim through a computer to a database at a first management level (see paragraph 0147, note that the disclosed system relies on computer input and databases to facilitate transactions, see paragraphs 0068 and 0075); determining the monetary value of the claim (see paragraph 0148); approving or denying the claim at the first management level when the monetary value of the claim is below a first predetermined level (see paragraphs 0148 and 0152). Hicks further teaches multiple management levels involved in processing the input claims (see paragraph 0148). Hicks does not explicitly teach that second and third management levels review the input claims to approve or deny the claims when the monetary value of the claim is above a first and second level respectively. Barr teaches a system for insurance claims management in which unprocessed payments for claims are routed to the appropriate management level for

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review based on whether the claim amounts are above or below each management level's corresponding payment authorization amount (see column 52, lines 15-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these claim processing features into the warranty claims processing method of Hicks. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of facilitating the function of the top management level in Hicks to enforce the various operational standards of the other management levels (see paragraph 0072) by enabling more detailed processing of warranty claims based on their monetary value as described by Barr.

5. As per claim 2, Hicks in view of Barr teach the method of claim 1 as described above. Hicks further teaches a fourth management level to review all approved claims for accuracy and completeness and to inform the customer when a claim is denied and to inform an accounting management level when a claim has been approved and direct the accounting management level to reimburse the customer (see paragraph 0152).

6. As per claim 3, Hicks in view of Barr teach the method of claim 1 as described above. Hicks further teaches the step of inputting a claim through a computer further includes the steps of accessing the corporate database through a computer connected to a corporate network, and opening a new record file for the customer (see paragraph 0172).

7. As per claim 4, Hicks in view of Barr teach the method of claim 3 as described above. Hicks further teaches the step of accessing the corporate database through a computer connected to a corporate network further includes the step of entering a predetermined login name and a predetermined password to request access (See paragraph 0170, in particular, smartcard and PIN verification).

8. As per claim 5, Hicks in view of Barr teach the method of claim 3 as described above. Hicks further teaches the step of accessing the corporate database through a computer

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connected to a corporate network further includes the steps of accessing the internet through any capably equipped computer, electronically accessing a world wide web interface to the corporate network, and electronically connecting the computer to the corporate network through the internet and world wide web connections (see column 0168).

9. As per claim 6, Hicks in view of Barr teach the method of claim 5 as described above.

Hicks further teaches the step of electronically connecting the computer to the corporate network through the internet and world wide web connections further includes the step of entering a predetermined login name and a predetermined password to request access (see paragraph 0170, in particular, smartcard and PIN verification).

10. As per claim 7, Hicks in view of Barr teach the method of claim 6 as described above.

Hicks further teaches the step of inputting a claim through a computer further includes the step of selecting from a menu at least one operational link to another page for input of claim specific data (see paragraphs 0147 and 0168, because the system relies on a computer interface, including a browser, and application software, it is submitted that some sort of "page," such as a browser page, is relied upon for input of data).

11. Claims 8-11 recited substantially similar limitations to those already addressed in claims 3-6 with the exception that they are directed to inputting an approval or denial of the claim.

Because inputting an approval or denial of a claim is taught as described above with respect to claim 1, claims 8-11 are rejected for substantially similar reasons to claims 3-6.

12. As per claim 12, Hicks in view of Monk teach the method of claim 11 as described

above. Hicks further teaches selecting from a menu at least one operational link to another page to generate a list of all open claims (see paragraphs 0147 and 0168, because the system relies on a computer interface, including a browser, and application software, it is submitted that some sort of "page," such as a browser page, is relied upon for input of data). As described

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above, Hicks does not explicitly teach the additional review by the second and third management levels. However, Monk teaches Barr teaches a system for insurance claims management in which unprocessed payments for claims are routed to the appropriate management level for review based on whether the claim amounts are above or below each management level's corresponding payment authorization amount (see column 52, lines 15-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these claim processing features into the warranty claims processing method of Hicks. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of facilitating the function of the top management level in Hicks to enforce the various operational standards of the other management levels (see paragraph 0072) by enabling more detailed processing of warranty claims based on their monetary value as described by Barr

13. As per claim 13, Hicks in view of Monk teach the method of claim 12 as described above. As described above, Hicks does not explicitly teach the additional review by the second and third management levels. Barr further teaches selecting one claim file from the list of all open claims to select a specific claim to review (see column 52, lines 15-58, those claims identified as being above the payment authorization amount are interpreted by the Examiner to be the list of "all open claims"). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Hicks for the reasons given above with respect to claim 12.

14. Claims 15 and 16 recite substantially similar limitations to those already addressed in claims 12 and 13 with the exception that they are directed to the third management level. Because this feature has already been addressed in claim 1, these claims are rejected for similar reasons to claims 12 and 13.

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15. Claim 18 recites substantially similar limitations to those already addressed in claims 12 and 13 with the exception that claim 18 is directed to the fourth management level. Because this feature has already been addressed in claim 2, this claim is rejected for similar reasons to claims 12 and 13.

16. Claims 19 and 20 recite substantially similar limitations to claims 1 and 2 with the exception that they specify that the claim occurs either after the expiration of a specified warranty period or within a specified warranty period. Hicks further teaches these time frames for filing a claim (see paragraphs 0144-0146). Therefore, these claims are rejected for similar reasons to claims 1 and 2.

17. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks et al., U.S. Patent Application Publication No. 2004/0111379 in view of Barr et al., U.S. Patent No. 5,182,705 and further in view of Luedtke, U.S. Patent Application Publication No. 2003/0018497.

18. As per claim 14, Hicks in view of Monk teach the method of claim 13 as described above. Hicks does not explicitly teach the use of an approve or deny web page button to indicate claim decisions. Luedtke teaches a method that includes the feature of an approve or deny web page button to approve or deny financial terms of a reinsurance contract (see Figure 6, elements 85 and 86). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Hicks. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of expediting insurance related transactions, such as claim approval or denial, through user friendly interface presentation (see paragraph 0011 of Luedtke).

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19. Claim 17 recites substantially similar limitations to those already addressed in claim 14 with the exception that it is directed to the third management level. Because this feature has already been addressed in claim 1, this claim is rejected for similar reasons to claim 14.

Response to Arguments

20. In the remarks filed 11/2/05, Applicant argues in substance that (1) Hicks does not process claims against a manufacturer's product; (2) Hicks does not access the monetary value of the particular claim; (3) Hicks does not teach approving or denying the claim at the first management level when the monetary value is below a first predetermined level; (4) neither Hicks nor Barr teach the second and third management level elements as recited; (5) neither Hicks nor Barr process claims against a manufacturer's product after the expiration of a specified warranty period nor for ancillary costs arising from customer expenses; (6) neither Hicks nor Barr teach the fourth management level as recited; (7) there is no motivation to combine the teachings of Hicks and Barr; and (8) the combination of Hicks and Barr rely upon hindsight reasoning,

21. In response to Applicant's argument (1), it is respectfully submitted that this element of the claim is only recited in the preamble and the body of the claim makes no mention of, nor any reference to, a manufacturer's product. Therefore the Examiner interprets this to be merely the intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the

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preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

22. In response to Applicant's argument (2), the Examiner respectfully disagrees with this interpretation of the teachings of Hicks. It is noted, for example, that at paragraph [0148] of Hicks, both the root entity and issuing participant are notified of "the filed claim and the amount of the claim." (emphasis added). It is clear, from the context of the Hicks reference, that the amount of the claim is the monetary value of the claim. Therefore, the Examiner respectfully submits that Hicks teaches this aspect of the claims as recited.

23. In response to Applicant's argument (3), the Examiner respectfully disagrees with this interpretation of the teachings of Hicks. Referring again to paragraph [0148], it is clear that the claim is approved or denied by a first management level (i.e. issuing participant). It is also clear that because the claim has some identified monetary value, as described above in response to argument (2), the claim is also below some level. It is also noted that there is no indication in the claim of what the predetermined level is, who or what determines or establishes is, nor how it is determined or established. Therefore, it is respectfully submitted that Hicks teaches this broad limitation as recited.

24. In response to Applicant's argument (4), it is respectfully submitted that these limitations are taught by the combination of Hicks and Barr. As described above, Hicks teaches a plurality of management levels that are involved in the processing of warranty claims. In addition, Barr describes a process of routing unpaid claims to different management levels based on claim amounts exceeding predetermined levels (see column 52, lines 45-50). In addition, as described above in response to argument (3), there is no indication in the claim of what the predetermined level is, who or what determines or establishes is, nor how it is determined or

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established. Therefore, it is respectfully maintained that the combination of Hicks and Barr would have suggested, to one of ordinary skill in the art, these broad limitations as recited.

25. In response to Applicant's argument (5), it is respectfully submitted that these elements of the claims are only recited in the preamble and the body of the claims make no mention of, nor any reference to, when a claim is made or any ancillary costs. Therefore the Examiner interprets this to be merely the intended uses of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

26. In response to Applicant's argument (6), it is first noted that there are no limitations recited in the claims of what constitutes "accuracy and completeness." Therefore, the Examiner has interpreted the teaching in Hicks of the "WCCM" monitoring all approved claims to meet this limitation. In addition, the Examiner notes that at paragraphs [0149] and [0150], the customer is notified if a claim is denied. It is also noted that at paragraph [0152], if a claim is to be paid to the customer, the relying participant is notified. Therefore, it is respectfully maintained by the Examiner that Hicks teaches this limitation as recited in the claims.

27. In response to Applicant's argument (7), the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either

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in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is respectfully submitted that Hicks establishes as a goal of the invention to set forth and regulate operation standards and process for the warranty system which includes processing of warranty claims (see paragraph [0072]). Therefore, it is respectfully submitted that one of ordinary skill in the art would have looked to other prior art references, such as that of Barr, for useful policies in claims processing.

28. In response to Applicant's argument (8), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it is respectfully submitted that the reasoning applied in response to argument (7) applies here as well. In particular, it is submitted that it would have been within the knowledge available to one of ordinary skill in the art at the time of the invention to look to other claims processing systems, with established policies for the processing of unpaid claims, for identifying useful policies to employ in the system of Hicks.

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CLG
1/23/06


JOSEPH THOMAS
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